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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,116	10/22/2001	David Sauer	IP1-0106	5698

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EXAMINER
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GENACK, MATTHEW W

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,116	<b>Applicant(s)</b> SAUER ET AL.	
	<b>Examiner</b> Matthew W. Genack	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,16,21,25,27,30,31,33,34,37,38 and 44-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,16,21,25,27,30,31,33,34,37,38 and 44-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8, 10, 21, 25, 33-34, 38, 44-47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk, U.S. Patent No. 6,768,789, in view of Shimoda *et. al.*, U.S. Patent No. 6,397,079.

Regarding Claim 1, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores a plurality of predefined outgoing messages (Column 3 Lines 36-41, Column 4 Lines 10-30). The predefined messages may be provided in a plurality of languages (Column 7 Lines 24-30). The callee selects an outgoing message and plays selected message for the caller (Column 5 Lines 49-62, Fig. 2).

Wilk does not expressly disclose the translation, by the processor of the wireless telephone, of a message that is to be sent by said wireless telephone, into a language

associated with the intended recipient of said message, nor does Wilk expressly disclose the inputting of recipient contact information into the wireless telephone for the purpose of sending the predefined message (since the predefined messages are sent back to the party that initiated the call).

Shimoda *et. al.* discloses a method for enhancing the memory and processing abilities of a wireless telephone via the use of a portable computer connected thereto, the wireless telephone and the portable computer thereby operating as one portable device (Abstract, Column 1 Lines 30-37 and 55-65, Fig. 5). This portable device may be used to translate the sending user's messages into a language used by the other party, said translation being done in the context of a telephone call initiated by said sending user (Column 3 Lines 3-24, Fig. 4).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by enabling the wireless telephone to translate any one of its predefined messages into a language associated with the intended recipient of that message, and to enable this process to be done not only with calls received by said wireless telephone, but also with calls initiated by said wireless telephone (wherein inputting recipient contact information is therefore necessary).

One of ordinary skill in the art would have been motivated to make this modification because the sender's act of translating a message into the language of a recipient who speaks a foreign language is an act of courtesy (as opposed to expecting the recipient to translate said message), especially in the context of a communication session initiated by that user.

Claims 4 and 33 differ substantively from Claim 1 in that the former Claims recite the use of a customizable concatenated message that is stored in the mobile memory, said message comprising at least one customizable text entry portion. Wilk discloses a wireless telephone memory that stores customizable concatenated outgoing messages, said messages having customizable portions that may be entered as text with the use of the wireless telephone's keypad (Column 4 Line 10 to Column 5 Line 4).

Claim 6 differs substantively from Claim 4 in that the former Claim recites a predefined portion, in addition to the customizable text entry portion, in the customizable concatenated message that is stored in the mobile memory. Wilk discloses a wireless telephone memory that stores customizable concatenated outgoing messages, said messages having customizable portions that may be entered as text with the use of the wireless telephone's keypad, as well as predefined portions (Column 4 Line 10 to Column 5 Line 4).

Claim 44 differs substantively from Claim 1 in that the former Claim recites a plurality of mobiles being involved in the communication. Wilk discloses two-way communication between the caller and the callee (Fig. 1). The caller may be using any type of wireless telephone that allows a connection to be made over the PSTN (Column 3 Line 56 to Column 4 Line 4).

Regarding Claims 5, 7, and 34, Wilk discloses that the callee may enter text information, via the wireless telephone's keypad, into the customizable text entry portion of the stored predefined messages (Column 4 Lines 41-53). The callee may specify the entry of default terms such as "buy" and "sell" into the customizable text entry portion for

certain types of stored predefined messages (Column 4 Line 65 to Column 5 Line 4).

The callee may enter defined information into the customizable text entry portion of the stored predefined message (Column 4 Lines 58-64).

Regarding Claim 8, the information inputted by the user, with the wireless telephone's keypad, comprises characters (Column 5 Line 63 to Column 6 Line 4).

Regarding Claims 10 and 38, Wilk discloses the use of predefined text for use with customizable messages (Column 4 Line 54 to Column 5 Line 4).

Regarding Claims 25 and 45-46, Wilk discloses that the wireless telephone communicates with the base station via a wireless link that may be based on CDMA (Code Division Multiple Access) (Column 3 Lines 2-5, Fig. 1). Since CDMA is a digital standard, information that is transmitted from a CDMA telephone is in a digital format. Voice and text that are inputted into such a wireless telephone are therefore encoded upon storage, and when transmitted, are also transmitted by code.

Regarding Claim 47, Wilk discloses the use of a keypad as the user interface (Abstract).

The rejections of Claims 21 and 49 are parallel to that of Claim 6.

4. Claims 3, 16, 27, 30-31, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Shimoda *et. al.*, further in view of Enns *et. al.*, U.S. Patent Application Publication 2002/0116499.

Claims 16, 27 and 48 differs substantively from Claim 44, and Claims 3 and 30 differ substantively from Claim 1, in that Claims 3, 16, 27, 30, and 48 recite the storage of a defined contacts list of message recipients in the wireless telephone's memory.

Neither Wilk nor Shimoda *et. al.* expressly discloses the storage of a defined contacts list of message recipients in the wireless telephone's memory.

Enns *et. al.* discloses a method and system for sending a message from a mobile device to one or several specified recipient(s), said recipient(s) being in a list stored in said mobile device (Abstract, [0004], [0017], [0019], [0059], Figs. 1 and 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk as modified by Shimoda *et. al.* by including a list of contacts in the wireless telephone and enabling the transmission of a message or messages to one contact, or to several respective contacts, in a language associated with said contact(s).

One of ordinary skill in the art would have been motivated to make this modification because contact lists allow quick and easy communication with one or more individuals, and the use of a contact list in this manner would allow a message to be sent to users in a plurality of languages.

Regarding Claim 31, Wilk discloses the use of a keypad as the user interface (Abstract).

5. Claims 9 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Shimoda *et. al.*, further in view of Makela *et. al.*, U.S. Patent Application Publication 2001/0028709.

Neither Wilk nor Shimoda *et. al.* expressly discloses the inclusion of calendar and clock information in outgoing messages.

Makela *et. al.* discloses a mobile communication device, capable of SMS, that includes time information in messages (Abstract, [0022], Fig. 1). Said time information comes from a clock or calendar program ([0027]).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk as modified by Shimoda *et. al.* by providing for the inclusion of either clock information or calendar information as the default information of certain customizable messages.

One of ordinary skill in the art would have been motivated to make this modification so that the recipients would know the time at which the sender sent the customizable message.

### ***Response to Arguments***

6. Applicant's arguments with respect to Claims 1, 3-10, 16, 21, 25, 27, 30-31, 33-34, 37-38, and 44-49 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 571-272-7541. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Genack

Examiner

TC-2600, Division 2617



5 April 2006

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**